REMARKS

I. Summary of Office Action

Claims 1-71 were rejected under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Claims 41-71 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 1-71 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brenner et al. U.S. Patent No. 6,099,409 (hereinafter "Brenner") in view of LaDue U.S. Patent No. 5,999,808 (hereinafter "LaDue").

II. Summary of Reply to Office Action

Claims 1, 17, 20-22, 32, 35, 36, 37, 40, 41 and 57 have been amended to more particularly point out and distinctly claim the invention. No new matter has been added by these amendments and the claims are fully supported and justified by the application as originally filed.

The rejections under 35 U.S.C. § 112, second paragraph, 35 U.S.C. § 101, and 35 U.S.C. § 103(a) based on Brenner in view of LaDue are respectfully traversed.

III. Reply to Rejection under 35 U.S.C. § 112

Claims 1-71 were rejected under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention. More specifically, the Office Action rejected claims 1, 32, 35, 36, 37, 40 and 41 for the recitation of the word "may," alleging that it renders the claims indefinite for not being clear and definite as to whether wagers are actually placed or not (see Office Action, page 4). Applicants respectfully disagree with the Office Action's conclusion, but

in the interest of advancing prosecution applicants have amended claims 1, 20-22, 32, 35, 36, 37, 40 and 41. In the amended claims, the use of the word "may" has been removed such that the racing data relates to "races that have not been run and that a user is allowed to place wagers on."*

Accordingly, applicants submit that the rejection of claims 1-71 under 35 U.S.C. § 112, second paragraph should be withdrawn.

IV. Reply to Rejection under 35 U.S.C. § 101

Claims 41-71 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. More specifically, the Office Action rejected claim 41 alleging that "the machine-readable medium (floppy disc or CD-ROM) itself can not be directed to a practical application of the invention in the useful art to accomplish a concrete, useful, and tangible result. When the computer program in the medium is actually executed by the computer, the claimed subject matter produces a useful concrete and tangible result" (Office Action, page 5). Applicants respectfully traverse this rejection.

As stated in the preamble of claim 41, the machine-readable medium comprises machine program logic and is implemented using a cellular telephone. Applicants submit that claim 41 satisfies the requirements set forth above by the Office Action. Using the Office Action's requirements as a guide, the machine program logic may be considered the computer program and the cellular telephone may be considered the computer. Under this construction, a computer program is executed by a computer because the machine program logic is

* Although not pointed to by the Office Action, claims 20-22 also recited the word "may" and these claims are dependent upon claim 1. Therefore, claims 20-22 have also been amended to to remove the word "may" and properly depend from claim 1.

implemented using a cellular telephone.

Accordingly, applicants submit that claim 41 produces a useful, concrete and tangible result, and for at least this reason, the rejection under 35 U.S.C. § 101 of claims 41-71 should be withdrawn

V. Reply to Rejection under 35 U.S.C. § 103(a)

Applicants' independent claims 1, 32, 35, 36, 37, 40 and 41 are directed towards methods, systems and machine-readable media for interactive wagering on races with a cellular telephone. For example, as defined by independent claims 1 and 41, racing data on races that have not been run and that a user is allowed to place wagers on are received at the cellular telephone. A user is allowed to select to present the racing data in audio form or visual form and the racing data is presented on the cellular telephone based on the user selection. Interactive options are provided on the cellular telephone that allow the user using the cellular telephone to place a wager on a given race that has not been run.

Generally speaking, Brenner refers to systems and methods for interactive off-track wagering. Brenner, however, as admitted in the Office Action, "does not expressly disclose the method for interactive wagering utilizing a cellular telephone that is in a wireless data communications network" (Office Action, page 6). Nevertheless, the Office Action contends that "it would have been obvious at the time the invention was made to a person having ordinary skill in the art to replace the conventional wireline data communications network system of Brenner with the wireless cellular radio system, as taught by LaDue, for the purpose of providing the user with a portable, wireless two way data communications gaming or wagering system" (Office Action, pages 5-6). In particular, LaDue provides "a cellular telephone" (Office Action, page 6).

The Office Action further contends that "presenting data in audio form or visual form" is disclosed in either Brenner or LaDue (see Office Action, page 3). Applicants submit, however, that the Office Action's rejection did not consider applicants' claims in their entirety. Applicants' claims include, *inter alia*, features directed to "allowing a user to select to present the racing data in audio form or visual form" and "presenting the racing data . . . based on the user selection." Therefore, the rejection did not consider that applicants' claims are directed to allowing the user to select one of two options for the presentation of data and presenting the data based on which option the user selected. Moreover, applicants' claims patentably improve upon Brenner in combination with LaDue at least by requiring "allowing a user to select to present the racing data in audio form or visual form" and "presenting the racing data . . . based on the user selection."

Moreover, the Office Action did not provide a sufficient motivation for combining Brenner with LaDue. See In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"). See also MPEP §§ 2142 and 2143.01. The Office Action contends that it would have been obvious to combine Brenner with LaDue "for the purpose of providing the user with a portable, wireless two way data communications gaming or wagering system" (Office Action, page 6). The Office Action further contends that LaDue teaches a user placing bets from a remote location (see Office Action, page 3). However, LaDue is not related to horse racing and does not consider the complexities relating to racing data permitting a combination with Brenner. Therefore, without a proper motivation for

combining the references, the Office Action has "simply take[n] the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability," a practice that is insufficient as a matter of law. In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999); see also In re Lee, 277 F.3d 1338, 1344 (Fed. Cir. 2002) ("[i]t is improper, in determining whether a person of ordinary skill would have been led to a combination of references, simply to use that which the inventor taught against its teacher").

Therefore, for at least the foregoing reasons, applicants respectfully request that the rejection of claims 1-71 under 35 U.S.C. § 103(a) be withdrawn.

VI. Conclusion

For the reasons set forth above, claims 1-71 are in condition for allowance. This application is therefore in condition for allowance. Reconsideration and allowance are accordingly respectfully requested.

Respectfully submitted,

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